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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,925	06/27/2001	Mitsuhiro Yano	198786US2 RE	3745
22850	7590	05/10/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			CRANE, SARA W	
			ART UNIT	PAPER NUMBER
			2811	

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/891,925

Applicant(s)

YANO ET AL.

Examiner

Sara W. Crane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

The examiner has received the following holding from the tech center reviewer:

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

"The original oath filed on June 27 201 does not comply with 37 C.F.R. 1.175 because it does not meet the requirements of 37 CFR 1.63 a(4). 37 CFR 1.63 a(4). states that the person making the oath or declaration believes the named inventor or inventor to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

The language first inventors is missing."

The language of MPEP 1444 was quoted as well:

#### 1444 Review of Reissue Oath/Declaration

In accordance with 37 CFR 1.175, the following is required in the reissue oath/declaration:

- (A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid-
  - (1) by reason of a defective specification or drawing, or
  - (2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;
- (B) A statement of at least one error which is relied upon to support the reissue application, i.e., which provides a basis for the reissue;
- (C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath /declaration arose without any deceptive intention on the part of the applicant; and
- (D) The information required by 37 CFR 1.63.

MPEP § 1414 contains a discussion of each of the above elements (i.e., requirements of a reissue oath/declaration). The examiner should carefully review the reissue oath/declaration in conjunction with that discussion, in order to ensure that each element is provided in the oath/declaration. If the examiner's review of the oath/declaration reveals a lack of compliance with any of the requirements of 37 CFR 1.175, a rejection of all the claims under 35 U.S.C. 251 should be made on the basis that the reissue oath/declaration is insufficient.

In preparing an Office action, the examiner should use form paragraphs 14.01 through

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14.01.04 to state the objection(s) to the oath/declaration, i.e., the defects in the oath/declaration. These form paragraphs are reproduced in MPEP § 1414. The examiner should then use form paragraph 14.14 to reject the claims under 35 U.S.C. 251, based upon the improper oath/declaration.

Although the instructions of MPEP 1444 as quoted to the examiner require the examiner to use one of form paragraphs 14.01 through 14.01.04 to state the objection to the oath/declaration, none of these form paragraphs appear to apply to the situation noted above. The examiner has therefore used form paragraph 14.01.05 instead, which is a "general" objection. In addition, the following form paragraph 14.14 rejects the pending claims, as required, based on the improper oath/declaration.

Claims 1-22 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath/declaration is set forth in the discussion above in this Office action.

The following is the examiner's discussion of the defect noted above:

The "Reissue Declaration under 37 C.F.R. 1.132" filed 27 June 2001 includes the language (at 3. on the first page), "We verily believe ourselves to be the original and joint inventors of the invention . . . ."

MPEP 1444 states that the information required by 37 CFR 1.63 must be provided. 37 CFR 1.63 states that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the

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subject matter which is claimed and for which a patent is sought. The examiner agrees that the language "original and first inventor or inventors" does not appear in the Declaration of 27 June 2001.

What is not clear to the examiner is whether there is any difference in meaning between the information provided by the statement of the declaration, and the information that would have been provided if the language "first inventor or inventors" had been included. It appears to the examiner that the meaning is the same, and that the objection to the declaration is formal, rather than substantive. In other words, the defect could be remedied simply by providing a supplemental declaration containing the specific language desired by the reviewer. (Perhaps the language was inadvertently left out.) In other words, the examiner's conclusion is that all claims would be allowable. If, however, Applicant did not include the "first inventor or inventors" language because Applicant discerns some difference in meaning between the language of the oath as provided on 27 June 2001, and the language including this phrase, some explanation is requested. Did Applicant intend some difference in meaning between the language "original and joint inventors" and the language of Rule 63 "original and first inventor or inventors"?

Examiner notes that the Notice of Allowance for this case signed by the examiner "cannot be cleared for mailing" until the tech center reviewer is satisfied. However, the reviewer does not wish to be named in the record. So if there are any questions related to the above noted defect, Applicant should contact the examiner directly. Examiner

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also notes that the objectionable language discussed above was not objected to previously on review, so perhaps there is some more recent decision or memorandum, unknown to the examiner, that is of concern here.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Crane, whose telephone number is (571) 272-1652.

The supervisor for Art Unit 2811, Eddie Lee can be reached on (571) 272-1732. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sara W. Crane  
Primary Examiner  
Art Unit 2811